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MAY 23 2003

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**UNITED STATES PATENT & TRADEMARK
OFFICE**

**UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231**

Ralph E. Jocke
Walker & Jocke
231 South Broadway
Medina, OH 44256

Paper No. 15

In re Application of
Harold V. Putman
Application No. 09/233,249
Filed: January 19, 1999
For: AUTOMATED TRANSACTION
MACHINE AND METHOD

DECISION ON PETITION UNDER
37 C.F.R. 1.181 TO WITHDRAW
EXAMINER'S ANSWER AS
CONTAINING AN IMPERMISSIBLE
NEW GROUND OF REJECTION

This is a decision on the petition under 37 CFR 1.181 filed May 20, 2002 (Paper No. 13) that the Examiner's Answer contains an impermissible new ground of rejection and that the Examiner's Answer (Paper No. 11, mail date March 21, 2002) be withdrawn.

The petition is **DENIED**.

CASE HISTORY

This application was filed on January 19, 1999, with originally presented claims 1-27.

The Preliminary Amendment, Paper No. 3 filed August 4, 2000, amended claim 1 and added new claims 28-40.

The Examiner then issued a non-final rejection, Paper No. 4 mailed May 23, 2001, of claims 1-40 utilizing an Internet publication to Bosak (Bosak, Jon; "XML, Java, and the future of the web"; <http://www.ibiblio.org/pub/sun-info/standards/xml/why/xmlapps.htm>; 3/10/1997).

Applicant then submitted a response, Paper No. 5 filed August 7, 2001, which amended claims 13, 20-22, 24-27, 32, and 40, and added new claims 41-56, and arguing that the

Bosak reference was not prior art since the Examiner had not established a publication date.

The Examiner then issued a Final rejection, Paper No. 6 mailed October 19, 2001, of claims 1-56 and stated in the response to arguments that the "Last Revised" date of Bosak was the publication date.

Applicant then submitted a Request to Withdraw Finality, Paper No. 7 filed December 19, 2001, again arguing that Bosak was not prior art, and a Notice of Appeal, Paper No. 8 filed January 15, 2002.

The Examiner issued an Advisory Action, Paper No. 9 mailed February 5, 2002, indicating that the Bosak reference was considered as prior art as of the "Last Revised" (or publication) date.

Applicant then submitted an Appeal Brief, Paper No. 10 filed February, 27, 2002, again with arguments directed to Bosak not being prior art.

The Examiner subsequently issued an Examiner's Answer, Paper No. 11 mailed March 21, 2002, and Applicant submitted a Reply Brief, Paper No. 12 filed May 20, 2002.

RELIEF REQUESTED

The petition under 37 CFR § 1.181 states that the Examiner's Answer contains "at least one impermissible new ground of rejection within the meaning of 37 CFR § 1.193(a)(2)" and requests that "the Examiner's Answer be withdrawn."

REGULATIONS AND PRACTICE

37 C.F.R. § 1.193 states in part:

(a)(2) An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

MPEP 1208.01 states in part:

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

and also that:

A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). However, where a newly cited reference is added merely as evidence of the prior well known statement made by the examiner, the citation of the reference in the examiner's answer would not constitute a new ground of rejection within the meaning of 37 CFR 1.192(a)(2). See also MPEP § 2144.03.

37 C.F.R. § 1.181 states in part:

(a) Petition may be taken to the Commissioner: (2) In cases in which a statute or the rule specify that the matter is to be determined directly by or reviewed by the Commissioner

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner.

OPINION

The remedy requested hinges on the determination of the propriety of the citation of the reference "W3C Architecture Domain [Extensible Markup Language (XML)]" in the Examiner's Answer.

Applicant presents the following arguments in support of the position that the Examiner's Answer contains an impermissible new ground of rejection:

"On page 11, lines 9-18, the Examiner's Answer states that a newly acquired document entitled 'Extensible Markup Language (XML)' provides evidence of the date of a previously cited Bosak Internet publication. Although the Examiner's Answer correctly admits that the new document is not prior art, the Examiner's Answer goes on to argue that the Extensible Markup Language (XML) document indicates that Bosak's March 1997 article entitled 'XML, Java, and the Future of the Web' was presented at a First XML Conference in San Diego, CA."

"The facts show that the Final Action ('Action') dated October 19, 2001 specifically applied the Bosak reference as a prior art publication for purposes of rejecting claims 1-44, 50, and 52-56 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). Appellant's Appeal Brief argues against the assertion that the Bosak reference is a prior art publication. Appellant's argument was based on the Office's interpretation of the Bosak reference as a publication in the Action and from which the appeal was taken. Therefore, it is respectfully submitted that this new interpretation of Bosak as a prior art presentation or public use by the Office constitutes an impermissible new ground of rejection. Under 37 C.F.R. § 1.193(a)(2) the entry of a new ground of rejection in an Examiner's Answer is clearly prohibited."

"In addition, although the Examiner asserts that he is not relying on the teachings of the new document as part of any art rejection, the inclusion of the argument in the Examiner's Answer that the Bosak material was presented at the San Diego conference nevertheless is a new ground of rejection. Furthermore, a reference merely cited for the first time in an Examiner's Answer generally will constitute a new ground of rejection (MPEP § 1208.01). Appellants respectfully submit that the manner in which the new document and alleged Bosak presentation was cited, discussed, and/or apparently applied clearly constitutes an impermissible new ground of rejection within the meaning of 37 C.F.R. § 1.193(a)(2) which clearly prohibits the entry of a new ground of rejection in an Examiner's Answer. Therefore the citation, discussion, and/or apparent application of the new document and alleged Bosak presentation in the Examiner's Answer is legally improper due to noncompliance with the clear wording of both the statute and the regulations and the Office procedures promulgated thereunder."

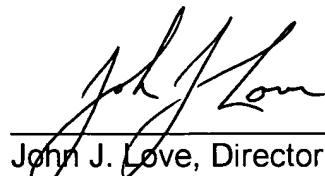
DECISION

The Examiner has set forth and maintained since the first Office action on May 23, 2001, that the Bosak reference constituted prior art based on the understanding that the "Last Revised" date constituted a publication date under 35 USC 102 and 103. It is respectfully submitted that the Examiner did not change his rejection, or his ground of rejection, in the Examiner's Answer; the rejections under 35 USC 102 and 103 were maintained as set forth throughout the entire prosecution of the instant application. Instead, in the Response to Argument section of the Examiner's Answer beginning at page 11, the examiner provided further evidence of said publication date by indicating that "The First XML Conference was held in San Diego, CA by the GCA and Jon

Bosak's March 1997 article entitled 'XML, Java, and the future of the web' was presented." (Examiner's Answer, at page 11). It is applicant's inability to understand that the "Last Revised" date on Bosak is the publication date that caused the Examiner to look for further evidence that the Bosak Internet publication was available as of the March 10, 1997 date. The citation of this document was solely for the purpose to provide further evidence of the publication date that the Office has maintained from the first Office action was March 10, 1997. Accordingly, the Petition is **DENIED**.

The application will be forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Summary: *Petition Denied*



John J. Love, Director
Patent Technology Center 3600
(703) 308-1020
(703) 306-4597 (facsimile)

Re

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